



Appl. No : 09/621,234 Confirmation No.: 3325
Applicant : HENSHAW et al.
Filed : July 20, 2000
Title : VERTICAL CYLINDRICAL SKEIN OF HOLLOW FIBER
MEMBRANES AND METHOD OF MAINTAINING CLEAN FIBER
SURFACES
TC./A.U. : 1723
Examiner : FORTUNA, Ana M.
Docket No. : 4320-241
Customer No. : 001059

Board of Patent Appeals and Interferences
United States Patent and Trademark Office
P. O. Box 1450
Alexandria, Virginia 22313-1450

January 29, 2007

REPLY BRIEF

The Appellants make the following submissions in reply to the Response to Arguments section of the Examiner's Answer. The Appellants do not admit any points made in the Examiner's Answer that are not specifically addressed below.

Related Appeals and Interferences

Related appeals were previously pending in U.S. Application Serial Nos. 11/008,977; 11/049,988; and, 11/059,403. The appeals in U.S. Application Serial Nos. 11/049,988 and 11/059,403 were terminated by the Examiner re-opening prosecution and providing a fresh Office Action. The appeal in U.S. Application Serial No. 11/008,977 was terminated by the Applicants filing a Request for Continued Examination. There are currently no pending related appeals or interferences.

Reply to Examiner's Response to Argument

For convenience, the Applicants repeat the relevant limitations of the cancelled claims, the claims of Patent No. 5,783,083 and claims 15-18 and 23 of the present application below:

Cancelled Claims:

No limitations regarding fiber spacing

Claims 1 and 9 of Patent No. 5,783,083:

each said header having said fibers spaced apart by a flexible support means having a thickness corresponding to a desired lateral spacing between adjacent fibers, said support means extending over only each terminal portion of said fibers near their ends, so as to maintain said ends in closely-spaced apart relationship

Present Application Claims 15-18 and 23:

at least a portion of the membranes spaced apart from adjacent membranes by the potting material to a center to center distance in the range from 1.2 to 5 times the outside diameter of the membranes

The first step in the three step test for recapture (MPEP 1412.02) is to determine in what respect the claims of the patent being reissued differ from the claims of the reissue application. The Examiner notes that the words "flexible support means" occur in the claims of the issued patent but not claims 15-18 and 23 of this application. The Examiner argues that the words "flexible support means" in the claims of Patent No. 5,783,083 are limited to "flexible planar support means such as strips or cards..." The Applicants disagree. The words "planar...such as strips or cards" are not in the claims of Patent No. 5,783,083. While strips or cards are mentioned as examples of flexible support means in the application, there is no basis for reading these words from the specification into the claims. However, even if the Applicants are not correct as to the interpretation of "flexible

support means", the first step alone is not determinative of recapture. This application was filed within two years of the issue of Patent No. 5,783,083 and so broadening is permissible. A broadening aspect may exist without recapture. Instead, any broadening aspect identified in the first step must be considered further under the second and third tests.

Regarding the second test, the Applicants are not sure what the Examiner's comments mean. If the Examiner was intending to point out that a defined "fiber spacing range" was not a part of the claims of application No. 08/690,045, the Applicants agree. The limitation of a center to center distance in the range from 1.2 to 5 times the outside diameter of the membranes appearing in claims 15-18 and 23 of this application is a narrowing aspect of these claims not found in the claims of Application No. 08/690,045 at any time or the claims issued as Patent No. 5,783,083. If the Applicants use of the words "fiber spacing" to name an area of subject matter in their initial Brief has caused some confusion, then the Applicants wish to clarify that the subject matter surrendered in application no. 08/690,045 is a membrane device having no limitations as to fiber spacing. Present claims 15-18 and 23 seek to claim a membrane device with limitations as to fiber spacing and so do not seek to recapture any surrendered subject matter.

Regarding the third test, the Examiner states that the "flexible support means" is an omitted limitation. The Applicants respectfully submit that this comment does not correctly apply the third test. The third test requires comparing the reissue claims (present application claims 15-18 and 23) with the claims of the original application (08/690,045) before they were amended to secure Patent No. 5,783,083. Those claims did not have a "flexible support means". Accordingly, it is incorrect to state in a discussion of the third test, that "flexible support means" is an omitted limitation. Those words did not appear in the claims of application No. 08/690,045 before the final amendment that resulted in patent No. 5,783,083. Therefore there is no recapture.

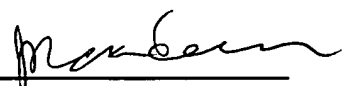
The Examiner further refers to the "flexible support means" as being an "essential element". The Applicants submit that a "flexible support means" is not an "essential element". For example, column 7, lines 35-42 of Patent No. 5,783,083 say that the choice of potting method is not critical. For further example, column 14, lines 28-31, describe a potting process in which flexible support means are used to space the membranes but are not part of the header. The Examiner has provided no evidence to establish that a flexible support means is essential and, in any event, whether an element is "essential" is not part of the test for recapture.

The Examiner further states that the Applicants argued in an Amendment/Response filed on 1/12/1998 that membranes spaced by a flexible support means provided an advantage over prior art with fibers spaced by some other means. The Applicants respectfully disagree. Referring to pages 10 to 12 of that response, the Applicants argued that the prior art Kunio device had membranes that were in contact with each other and so not spaced at all. The present claims 15-18 and 23 are narrower than the claims prior to the Amendment/Response of 1/12/1998 in that they require the membranes to be spaced within a defined range. Accordingly, the present claims are consistent with the Applicants prior Amendment/Response.

For these reasons, the Applicants submit that the present claims do not seek to recapture abandoned subject matter and that this appeal and application are allowable.

Respectfully submitted,

HENSHAW et al.

By 
James A. Raakman
Reg. No. 56,624
Tel: 416-957-1654